

REMARKS

The above amendments and following remarks are submitted in response to the First Official Action of the Examiner mailed January 25, 2002. Having addressed all objections and grounds of rejection, claims 1-20, being all the pending claims, are now deemed in condition for allowance. Reconsideration to that end is respectfully requested.

The Examiner has made a number of objections to the specification. The above amendments as supported by Appendix A are deemed to fully address these objections.

The Examiner has objected to claim 16 as containing a typographical error. Claim 16 has been amended above in accordance with this rejection.

Enclosed herewith are new formal drawings modified in accordance with the objections of the Chief Draftsperson. These new formal drawings have been modified only to remedy the alleged informalities. No new matter has been added.

The Examiner has rejected claims 1-4, 6-8, 11-14, and 16-18 under 35 U.S.C. 103(c) as being unpatentable over U.S. Patent No. 5,941,947, issued to Brown et al (hereinafter referred to as "Brown"). This ground of rejection is respectfully traversed for the reasons provided below.

MPEP 2142 provides in part:

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

The Examiner has failed to present a *prima facie* case of obviousness. The requirements of a *prima facie* case of obviousness are given in MPEP 2143. This requires three showings. The Examiner must provide: 1) motivation for the alleged combination; 2) reasonable likelihood of success of the alleged combination; and 3) all of the claim elements taught within the alleged combination. The Examiner has not made these showings.

As to claim 1, the Examiner (citing Figs. 3A-10, and column 16, line 28, through column 19, line 7) clearly erroneously finds that Brown has a "security profile corresponding to a site". In accordance with Applicants' claimed invention, this means a site specific UserID and Password (see specification at page 7, lines 9-16). In other words, claim 1 and the claims depending therefrom) is limited to a system wherein the physical location of a user terminal is determinative of permission to make certain data base accesses. This type of security profiling is significant in that it permits combining logical security with physical security as discussed at page 7, line 21 through page 8, line 3. There is no showing in Brown of any site specific security profiles.

Claim 1 (and the claims depending therefrom) is also limited to a system wherein the user terminal is coupled to the data base management system via "a publically accessible digital data communication network". Brown, on the other hand, is limited to a Wide Area Network (WAN 106) which couples Multiple Client Microcomputers 102 to Host Data Center 104. This is incompatible with "a publically accessible digital data communication network" because it relies upon dedicated WAN lines 108 (see column 6, line 65, through column 7, line 6).

Claim 1 is also limited by a data base management system having at least one data base. The Examiner has freely admitted that Brown does not have this limitation. Thus, the alleged combination of Examiner lacks: 1) site specific security profiles; 2) a publically accessible digital data communication network; and 3) a data base management system having at least one data base.

The Examiner does not address these deficiencies except to state:

However ,it would have been obvious to one of ordinary skill in the art at the time of the invention to extend the teaching of **Brown et al.** to include access to a database in a database management system, since databases are used to store a significant amount of the data available on the Internet;(emphasis added)

The Examiner provides no authority for to "extend" the teaching of Brown. In fact MPEP 2143 states in part:

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). rejection under 35 U.S.C. 103.

Yet it is clear that it is within Applicants' disclosure that the Examiner has found these limitation, which are not other wise of record in this prosecution and certainly not in Brown.

Thus, the rejection of claim 1 (and the claims depending therefrom) is respectfully traversed for the Examiner having failed to make a *prima facie* case of obviousness as required by MPEP 2143.

The rejection of claim 6 is respectfully traversed for a similar failure to make a *prima facie* case of obviousness. Claim 6 is limited by the combination of three elements: 1) user terminal located at a site; 2) data base management system ...coupled...via a publically accessible ...network; and c) security profile generated by said database management system corresponding to said site ... The Examiner alleges that Brown teaches "a user terminal located at a site". Though Brown teaches only that the multiple client microcomputers 102 are geographically dispersed, it does not teach anything about their location at a "site". However, it is admitted that such a location is implied. The remaining two elements are not taught by Brown.

Though the second element is clearly a "data base management system..." and the Examiner freely admits that Brown does not have a data base management system, the Examiner disingenuously states that Brown has a "data entity" responsively coupled....". Clearly, the Examiner has recognized that Brown does not meet this limitation of claim 6, but is unwilling to admit it. Furthermore, the "coupling" element of claim 6 is a "publically accessible" network not shown in Brown as discussed above.

The third element is a "security profile generated by said data base management system". Again, recognizing that Brown does not meet this limitation, the Examiner rewrites the claim element to be "a security profile generated by the system". That this security profile corresponds to the "user terminal location site" in the claimed invention is totally ignored by the Examiner. As explained above, Brown does not teach or suggest a "site specific" security profile.

Thus, the rejection of claim 6 (and all claims depending therefrom) is respectfully traversed for failure of the Examiner to present a *prima facie* case of obviousness.

Claim 11 is a five step method claim. Element (b requires "receiving said service request by said remote data base management system". The Examiner admits that Brown has no "data base management system". Therefore, Brown does not teach this limitation. Instead, the Examiner again disingenuously

disregards this limitation in applying Brown. Step c) requires "determining a security profile corresponding to said site". As explained above, Brown has no site specific security profile. Therefore, Brown cannot teach this limitation.

Thus, the rejection of claim 11 (and claims depending therefrom) is respectfully traversed for failure of the Examiner to present a *prima facie* case of obviousness.

Claim 16 is limited by three means-plus-function elements. Again the Examiner clearly erroneously finds that Brown has a "publically accessible network" instead of the Wide Area Network (WAN) actually found within the reference. Again, the Examiner admits that Brown has no "offering means" as is limiting of element b). Furthermore, the Examiner fails to read these claim limitations in view of the requirements of MPEP 2181 which provides the instruction from the Court of Appeals for the Federal Circuit stating in part:

Per our holding, the "broadest reasonable interpretation" that an examiner may give means-plus-function language is that statutorily mandated in paragraph six. Accordingly, the PTO may not disregard the structure disclosed in the specification corresponding to such language when rendering a patentability determination.

Thus, the rejection of claim 16 (and the claims depending therefrom) is respectfully traversed for failure of the Examiner to present a *prima facie* case of obviousness.

In rejecting claim 2, the Examiner again disingenuously rewrites to claim to correspond with Brown. Having admitted that

Brown does not contain a "data base management system", Brown cannot have a security profile generated by same. Thus, the Examiner must rewrite the claim language to make his rejection. The rejection of claim 2 (and claims depending therefrom) is respectfully traversed for failure of the Examiner to apply the reference to the claim language of record.

Claims 3, 8, 12, 13, and 18 are each limited to a special field within the service request which corresponds to the site of location of the user terminal. In making his rejection, the Examiner cites two portions of Brown, neither of which showing a field within the service request which identifies the site of location of the user terminal. To the extent that the Examiner actually believes that Brown shows such a site specific field within the service request, the Examiner's finding is clearly erroneous. The rejection of claims 3, 8, 12, 13, and 18 is respectfully traversed as based upon clearly erroneous fact finding.

Claims 4, 14, and 17 further limit the "publically accessible digital data communication network" to the Internet. As explained above, the Wide Area Network (i.e., WAN 106) of Brown is not "publically accessible". As if to underscore the problem with the rejections of the broader claims, the Examiner cites column 1, lines 57-67, in his rejection of claim 4, 14, and

17. This citation, part of the Background of the Invention, states in part:

...need for such networks to provide limited user access to the Internet...

It should be apparent to the most casual observer that the author completely distinguishes "such networks" from the "Internet" and that when WAN 106 is later discussed, it is the preferred mode of "such networks" and not the "Internet". Thus, the rejection of claims 4, 14, and 17 is respectfully traversed for failure of the Examiner to present a *prima facie* case of obviousness.

Claim 7 reads in its entirety:

The apparatus of claim 6 wherein said user terminal accesses said data base by transferring a service request to said data base management system. (Emphasis added)

The Examiner has already admitted that Brown has neither a "data base" nor "data base management system". Therefore, in making his rejection, the Examiner has again impermissibly rewritten the claim to state:

Regarding claim 7, **Brown et al.** Additionally teaches an apparatus wherein said user terminal accesses said data entry by transferring a service request to said system.

The rejection of claim 7 is respectfully traversed as based upon clearly erroneous findings of fact.

Claims 5, 9, 15, 19, and 20 have been rejected over the combination of Brown in view of the Admitted Prior Art. This ground of rejection is respectfully traversed for failure to

state a *prima facie* case of obviousness. Specifically there is shown no motivation or likelihood of success shown for the alleged combination. The Examiner has already admitted that Brown shows no data base management system at all. Therefore, Brown cannot be utilized to show either motivation for or likelihood of success of the alleged combination.

The Admitted Prior Art provides neither motivation nor reasonable likelihood of success. In fact, the Admitted Prior art actually teaches away from making the combination. The specification states at page 3, line 21, through page 4, line 6:

However , with the MAPPER system, as well as with similar proprietary data base management systems, the user must interface with the data base using a terminal coupled directly to the proprietary system and must access and manipulate the data using the MAPPER command language of MAPPER. Ordinarily, that means that the user must either be co-located with the hardware which hosts the data base management system or must be coupled to that hardware through dedicated data links. Furthermore, the user usually needs to be schooled in the command language of MAPPER(or other proprietary data base management system) to be capable of generating MAPPER Runs.

The problems of security and protocol incompatibilities are discussed in the specification at pages 5-6. Thus, one of skill in the art, knowing of these difficulties would be reticent to even consider the alleged combination.

Thus, the rejection of claims 5, 9, 15, and 19-20 is respectfully traversed as not presenting a *prima facie* case of obviousness as required by MPEP 2143.

Having thus responded to each objection and ground of rejection, Applicants respectfully request entry of this amendment and allowance of claims 1-20, being the only pending claims.

Respectfully submitted,
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By their attorney,

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